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BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

VERDIER, C

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 07/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/034,313

Applicant(s)

Claxton III et al.

Examiner

Christopher Verdier

Group Art Unit

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☒ Responsive to communication(s) filed on Jan 7, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16, 19-21, and 24-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-14 and 26 is/are allowed.

☒ Claim(s) 15, 16, 19-21, 24, and 25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicants' Amendment dated January 7, 2000 has been carefully considered but is deemed non-persuasive. Claims 1-16, 19-21, and 24-26 are pending. Claims 17-18 and 22-23 have been canceled. The Supplemental Reissue Declaration has been reviewed and complies with 37 CFR 1.175. A proper assent of assignee in compliance with 37 CFR 1.172 and 3.73 has been provided. The claims have been amended to remove the improper bracketing, as set forth in the Office action of July 7, 1999. The claims have been amended to overcome the rejections under 35 USC 112, second paragraph set forth in the Office action of July 7, 1999.

Applicants' arguments concerning the rejections of claims 1-4, 6-7, 15-17 and 20-22 under 35 USC 103(a) as being unpatentable over United Kingdom Patent 257,111 in view of Springer have been carefully considered and have been found to be persuasive. It is noted that the Declaration under 37 CFR 1.132 has been fully considered but is deemed moot in view of Applicants' arguments. Claims 1-14 and 26 are allowable over the prior art of record.

Applicants have argued that independent reissue claims 15, 20, and 26 do not attempt to recapture a scope of invention which was surrendered while prosecuting application serial number 08/321,587. It is initially noted by the examiner that claim 26 was previously allowed and not subject to a rejection under the Recapture Doctrine. With regard to independent reissue claims 15 and 20, the examiner respectfully disagrees with Applicants' arguments as set forth on pages 5-9 of Applicants' Remarks section. Applicants have argued that the amendments to originally filed

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claim 1 in application serial number 08/321,857 at most surrendered a claim scope which does not require a bearing cartridge. Applicants have further argued that the examiner's conclusion of recapture rests on a definition of surrendered claim scope that directly contradicts that adopted by the courts and the MPEP because the bearing cartridge of patent claim 1 was originally set forth in application claim 4, which was indicated as allowable in the first Office action, because original claim 1 of the '857 application which was rejected under prior art grounds in the first Office action did not recite any bearing cartridge, and that reissue claims 15 and 20 are materially narrower in this respect than pre amended claim 1. Applicants have argued that reissue claims 15 and 20 do not attempt to recapture a scope of invention which the patentees previously admitted as being unpatentable.

These arguments are not persuasive. Because then pending claim 1 in the application 08/321,857 which matured into U.S. Patent 5,496,150 was rewritten to include the allowable features of then pending dependent claim 4, the subject matter of **claim 1** in the issued patent was surrendered in order to overcome the prior art. The reason that then pending claims 4-15 were allowable over the prior art of record in the application 08/321,857 which matured into U.S. Patent 5,496,150 was that the prior art did not teach a bearing cartridge separably fastened within the diffuser core, with the bearing cartridge carrying axially spaced bearings. Hacker, which was of record in application 08/321,857 discloses in figures 1 and 2 two separate, removable bearing cartridges that each carry a single bearing, with the bearing cartridge 42 being in the diffuser core.

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The deletion of the language which was added to claim 1 (the separable bearing cartridge which includes axially spaced bearings as recited in claim 1, lines 23-26) of the issued patent in order to overcome the prior art and substitution of broader language in reissue claims is a violation of the Recapture Doctrine.

Note that as set forth in the Clement decision, “The recapture rule, therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor, 998 F.2d at 995, 27 USPQ2d at 1524. Under this rule, claims that are “broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution” are impermissible. Id. At 996, 27 USPQ2d at 1525.”

The examiner also respectfully disagrees with Applicants’ arguments regarding the applicability of the Clement decision.

In Clement, the court elucidated a detailed method of analyzing whether or not the recapture rule applies. The court explicitly stated that the first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims.

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The first Office clearly set forth the explicit language that was in the patent claims but was removed from the reissue claims.

In Clement, the Court said that the second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

The first Office action clearly pointed out what language was added to patent claim 1 to overcome the prior art rejection, make it allowable over the prior art, and cause the patent to issue.

The reissue claims have tried to remove claim language which was explicitly added to overcome a prior art rejection and therefore the reissue claims have been broadened in a material aspect, i.e., in an aspect that was material to the rejection that was overcome by adding the language now sought to be removed.

On balance, reissue claims 15-16, 19-21, and 24-25 are broader in a manner directly pertinent to the subject matter that Applicants surrendered (what was added to then pending claim 1 to make it allowable and issue as patent claim 1) during the prosecution of the patent.

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With regard to Applicants' argument that the examiner relies heavily on the fact the Examiner's Statement of Reasons for Allowability in the first Office action stated that the reason for indicating allowable subject matter in claim 4 was that the prior art did not teach a separable bearing cartridge which carries axially spaced bearings, and that the statement by the examiner does not equate to a prior admission by the patentees that the scope of a bearing cartridge presently recited in reissue claims 15 and 20 is not patentable, this argument is agreed with to the extent that a statement by an examiner of Reasons for Allowability does not necessarily equate to a prior admission by the patentees that the scope of an invention recited in reissue claims is unpatentable. Applicants also have requested that if this is the examiner's position, he provide some supporting authority for the notion that surrendered claim scope is determined by an examiner's Statement of Reasons for Allowability. This is not, in fact, the examiner's position that surrendered claim scope is determined by an Examiner's Statement of Reasons for Allowability. A careful review of the prosecution history of the '857 application, disregarding the examiner's Statement of Reasons for Allowability, reveals that the reason that claim 4 contained allowable subject matter was that the prior art of record did not teach a separable bearing cartridge which includes axially spaced bearings. However, by affirmatively choosing to amend claim 1 to incorporate the allowable features of dependent claim 4 in order to obtain a patent, the patentees have effectively surrendered any subject matter broader than that recited in amended claim 1.

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Reissue Rejections

Claims 15-16, 19-21, and 24-25 are rejected under the "Recapture Doctrine". See in the case law cited in MPEP 1412.02 and the recent decision, *In re Clement*, 45 USPQ 2d 1161 (Fed. Cir. 1997). In the parent application 08/321,857 which matured into US Patent 5,496,150, Applicants rewrote independent claim 1 to include the allowable limitations of claim 4 of the bearing cartridge being separably fastened within the diffuser core with the bearing cartridge carrying axially spaced bearings which surround and rotatably support the drive shaft and canceled dependent claim 4. These limitations were added by Applicants in the amendment dated July 28, 1995 in order to define over the prior art. The reason that claims 4-15 were allowable over the prior art of record was that the prior art did not teach a separable bearing cartridge which includes axially spaced bearings. The deletion of the language which was added to claim 1 of the issued patent in order to overcome the prior art and substitution of broader language in reissue claims is a direct violation of the Recapture Doctrine.

Allowable Subject Matter

Claims 1-14 and 26 are allowed.

Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities

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remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Verdier whose telephone number is (703) 308-2638. The examiner can normally be reached on Monday-Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look, can be reached on (703) 308-1044. The fax phone number for this Group is (703) 305-3588.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

CV
May 5, 2000



Christopher Verdier
Primary Examiner
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